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22852 7590 02/01/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER LIOU, ERIC	
			ART UNIT	PAPER NUMBER
			3628	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/628,411

Applicant(s)

GULLO ET AL.

Examiner

Eric Liou

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/22/04 and 7/9/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION***Priority***

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

2. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). The disclosure of the prior-filed application, Application No. 60/399,251, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 15 and 18-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 15 recites the limitation "the machine readable format" in line 1. There is insufficient antecedent basis for this limitation in the claim.

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6. As per claim 18, the phrase “means for billing a party for an adjusted postage amount if the initial postage amount is determined to be proper” is unclear. The Examiner interprets the phrase to mean billing a party for an adjusted postage amount if the initial postage amount is determined to be improper (an adjusted postage amount is billed to account for an improper initial postage amount).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 20-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Martin et al., U.S. Publication No. 2002/0046195.

9. As per claim 20, Martin teaches a computer-implemented method for adjusting postage on a mailpiece, comprising: estimating an amount of postage necessary for a mailpiece (Martin: paragraph 0057 “the user makes a postage purchase selection”); transmitting payment information (Martin: paragraph 0057, “At a step 766 the user swipes a credit card through the card reader slot 124.”); printing a postage label including a postage amount represented only in an electronically readable format (Martin: Figure 4, The Examiner notes, the postal indicia may include a machine-readable portion as shown in paragraph 0006.) and a verification information allowing a mailing system to

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subsequently adjust the mailing amount (Martin: Figure 4, The Examiner interprets the postage amount of the mailing label to be verification information.).

10. As per claim 21, Martin teaches the method of claim 20 as described above. Martin further teaches creating the postage label by producing a bar code that contains postal information (Martin: paragraph 006). The further purported limitations of claim 21—wherein the bar code contains a date, the postage amount, an addressee information, a sender information, and a digital signature—constitute nonfunctional descriptive material and should not be given patentable weight. Nonfunctional descriptive material cannot lend patentability to an invention that would otherwise have been anticipated by the prior art. Altering the type of information on a barcode amounts to mere labeling of data and does not functionally relate to the substrate of the method. See MPEP 2106.01 [R-5]. When descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability (see *In re Ngai*, 367 F.3d 1336, 1339; 70 USPQ2d 1862, 1864 (Fed. Cir. 2004); *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)). Thus, claim 21 fails to further limit the invention claimed in claim 20 and is rejected under the same logic as described above.

11. As per claim 22, Martin teaches the method of claim 21 as described above. Martin further teaches the bar code further comprises a number unique to the postage indicia (Martin: paragraph 0006).

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12. As per claim 23, Martin teaches the method of claim 21 as described above.

Martin further teaches the bar code is a two dimensional bar code (Martin: paragraph 0006).

13. As per claim 24, Martin teaches a computer-readable medium containing instructions for implementing a method for adjusting postage on a mailpiece (Martin: paragraph 0049), the method comprising: estimating a postage amount necessary for a mailpiece (Martin: paragraph 0057 “the user makes a postage purchase selection”); transmitting payment information (Martin: paragraph 0057, “At a step 766 the user swipes a credit card through the card reader slot 124.”); printing a postage label including a postage amount represented only in an electronically readable format (Martin: Figure 4, The Examiner notes, the postal indicia may include a machine-readable portion as shown in paragraph 0006.) and a verification information allowing a mailing system to subsequently adjust the mailing amount (Martin: Figure 4, The Examiner interprets the postage amount of the mailing label to be verification information.).

14. As per claim 25, Martin teaches the computer-readable medium of claim 24 as described above. Martin further teaches creating the postage label by producing a bar code that contains postal information (Martin: paragraph 006). The further purported limitations of claim 25—wherein the bar code contains a date, the postage amount, an addressee information, a sender information, and a digital signature—constitute nonfunctional descriptive material and should not be given patentable weight.

Nonfunctional descriptive material cannot lend patentability to an invention that would otherwise have been anticipated by the prior art. Altering the type of information on a

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barcode amounts to mere labeling of data and does not functionally relate to the substrate of the method. See MPEP 2106.01 [R-5]. When descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability (see *In re Ngai*, 367 F.3d 1336, 1339; 70 USPQ2d 1862, 1864 (Fed. Cir. 2004); *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)). Thus, claim 25 fails to further limit the invention claimed in claim 24 and is rejected under the same logic as described above.

15. As per claim 26, Martin teaches the computer-readable medium of claim 25 as described above. Martin further teaches the bar code further comprises a number unique to the postage indicia (Martin: paragraph 0006).

16. As per claim 27, Martin teaches the computer-readable medium of claim 25 as described above. Martin further teaches the bar code is a two dimensional bar code (Martin: paragraph 0006).

17. Claims 28-34 and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Montgomery et. al, U.S. Publication No. 2003/0101143.

18. As per claim 28, Montgomery teaches a system for preventing postage fraud comprising: a mailpiece including a stealth postage indicia comprising a unique parcel number and a unique postage number (Montgomery: Figure 2, "204" and "218" and paragraph 0088); a scanner for reading the unique parcel number and the unique postage

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number (Montgomery: Figure 8, "484" and paragraph 0112); and a database in communication with the scanner, for verifying that the unique parcel number and the unique postage number are assigned to each other (Montgomery: paragraph 0111, "The database management module 478 is configured for storing and retrieving assigned tracking ID's and associated postage information to and from the tracking information database 472.").

19. As per claim 29, Montgomery teaches the system of claim 28 as described above. Montgomery further teaches an electronic interface for transmitting the postage indicia to a user (Montgomery: Figure 3, "308").

20. As per claim 30, Montgomery teaches the system of claim 29 as described above. Montgomery further teaches the electronic interface is the Internet (Montgomery: paragraph 0091, communication links 314-322 may represent the Internet).

21. As per claim 31, Montgomery teaches the system of claim 28 as described above. Montgomery further teaches the database further verifies that the unique postage number has not been used on a second mailpiece (Montgomery: paragraph 0115).

22. As per claim 32, Montgomery teaches the system of claim 29 as described above. Montgomery further teaches the database is updated with a record for the new postage indicia (Montgomery: paragraph 0110, "The local memory 468 also stores a tracking information database 472 for storing each tracking ID that has been issued to an end user computer 308 and the postage information associated with each tracking ID, i.e., the information contained in the tracking ID request.").

23. As per claim 33, Montgomery teaches the system of claim 29 as described above. Montgomery further teaches the unique parcel number and postage number are compared

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to an parcel number and postage number retrieved from a new mail parcel that enters a shipper's system (Montgomery: paragraph 0115, The Examiner interprets the unique identifiers previously stored in the transaction database 491 to include unique identifiers retrieved from a new mail parcel).

24. As per claim 34, Montgomery teaches the system of claim 29 as described above. Montgomery further teaches the database is further updated with a new record for a new parcel scanned in by the scanner, wherein the new record comprises a unique parcel number and a unique postage number (Montgomery: paragraph 0112, "a transaction database 491 for storing records concerning every mail piece validated or rejected by the postage validation computer system 312, including the unique identifier(s) contained in the postage indicium, e.g., the tracking ID and postage vendor ID/user account/piece count (or ascending register).").

25. As per claim 42, Montgomery teaches a method of dispensing fraud protected postage via the internet, comprising: receiving an estimated weight for a parcel from a sender via a web page (Montgomery: Figure 2 and paragraph 0088, The Examiner interprets barcode 206 to include the estimated weight for a parcel. The Examiner notes, the centralized postage-issuing computer systems communicate with one another through communications links which may represent the Internet (paragraph 0091)); receiving payment from the sender for an initial postage amount for the parcel (Montgomery: Figure 2, "200", The Examiner notes, postal indicia indicates receiving a payment for the shipment of a parcel.); transmitting instructions to a user's computer for producing a stealth postage indicia, comprising at least two unique numbers, and wherein the stealth postage indicia represents the postage in only a machine readable form (Montgomery:

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Figure 2, “200”, Figure 3, “300”, and paragraph 0088); and verifying a postage label for a mailpiece by verifying the two unique numbers (Montgomery: paragraph 0115).

Claim Rejections - 35 USC § 103

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 1-6 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al., U.S. Publication No. 2002/0046195 in view of Sansone et al., U.S. Patent No. 5,019,991.

28. As per claim 1, Martin teaches a method for paying a proper amount of postage comprising: estimating a postage amount necessary to send a piece of mail (Martin: paragraph 0057, “At a step 764, the user makes a postage purchase selection...”); prepaying for the estimated postage amount (Martin: paragraph 0057, “the user swipes a credit card”); producing postage indicia comprising an indication, readable by machine only, of the estimated postage amount (Martin: paragraph 0057 and paragraph 0006, “The machine-readable portion was initially specified to be a two-dimensional barcode...”).

29. Martin does not teach affixing to a mailpiece a postage indicia; mailing the mailpiece; and paying an adjusted postage amount, subsequent to the mailing of the mailpiece, in response to a bill.

30. Sansone teaches affixing to a mailpiece a postage indicia (Sansone: column 5, lines 13-15); mailing the mailpiece (Sansone: column 5, lines 13-15); and paying an

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adjusted postage amount, subsequent to the mailing of the mailpiece, in response to a bill (Sansone: column 5, lines 19-21, "...if the postage was not correct, then in block 1012 the descending registers are appropriately debited to reflect the correct postage.").

31. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Martin to have included affixing to a mailpiece a postage indicia; mailing the mailpiece; and paying an adjusted postage amount, subsequent to the mailing of the mailpiece, in response to a bill as taught by Sansone for the advantage of eliminating the need to return mail to a user in the event of a short payment (Sansone: column 2, lines 35-36).

32. As per claim 2, Martin in view of Sansone teaches the method of claim 1 as described above. Martin further teaches prepaying the estimated postage amount comprises prepaying the estimated postage via the Internet (Martin: paragraph 0037, "in one embodiment communications network 108 is the Internet").

33. As per claim 3, Martin in view of Sansone teaches the method of claim 1 as described above. Martin further teaches digitally signing a postage amount, an addressee information, a sender information, and a date (Martin: paragraph 0017, "The server then validates the payment information, and upon validation, generates an indicium based on the request, where the indicium includes a digital signature." The Examiner interprets payment information to include a postage amount, an addressee information, a sender information, and a date.) and printing the digital signature, the postage amount, the addressee information, the sender information, and the date on the postage indicia in a machine readable format (Martin: Figure 4, "432").

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34. As per claim 4, Martin in view of Sansone teaches the method of claim 3 as described above. Martin further teaches the machine readable format is a bar code (Martin: paragraph 006).

35. As per claim 5, Martin in view of Sansone teaches the method of claim 4 as described above. Martin further teaches the bar code is a 2-dimensional bar code (Martin: paragraph 006).

36. As per claim 6, Martin in view of Sansone teaches the method of claim 1 as described above. Sansone further teaches verifying that the postage indicia has not previously been used on a second mailpiece (Sansone: column 6, lines 54-58, "Upon receipt of the postal imprint indicia, the CPU checks to confirm the correctness of the indicia as conforming to an authorized postal meter certification apparatus, previously established by the user". The Examiner interprets confirming the correctness of the indicia as conforming to an authorized postal meter certification apparatus to include verifying that the postage indicia has not been previously used on a second mailpiece.).

37. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Martin to have included verifying that the postage indicia has not previously been used on a second mailpiece as taught by Sansone for the advantage of eliminating costly acceptance procedures set forth by the post office for reviewing bulk mail requirements (Sansone: column 6, lines 43-45).

38. As per claim 11, Martin teaches a system for preventing postage fraud comprising: means for receiving an estimated postage amount necessary to send a parcel (Martin: paragraph 0057); a printer for electronically prepaying the estimated postage amount (Martin: paragraph 0057 and Figure 3, "310") and means for outputting a postage

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indicia comprising a stealth postage for the amount prepaid (Martin: paragraph 0057, Figure 3, “310”). Martin does not teach means for paying for an adjusted amount of postage subsequent to the mailing of the mailpiece.

39. Sansone teaches means for paying for an adjusted amount of postage subsequent to the mailing of the mailpiece (Sansone: column 5, lines 19-21, “...if the postage was not correct, then in block 1012 the descending registers are appropriately debited to reflect the correct postage.”).

40. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Martin to have included means for paying for an adjusted amount of postage subsequent to the mailing of the mailpiece as taught by Sansone for the advantage of eliminating the need to return mail to a user in the event of a short payment (Sansone: column 2, lines 35-36).

41. As per claim 12, Martin in view of Sansone teaches the system of claim 11 as described above. Martin further teaches the means for electronically prepaying comprises an Internet payment service (Martin: paragraph 0037, “in one embodiment communications network 108 is the Internet” and paragraph 0057).

42. As per claim 13, Martin in view of Sansone teaches the system of claim 11 as described above. Martin further teaches a printer for printing the postage indicia (Martin: Figure 3, “310”).

43. As per claim 14, Martin in view of Sansone teaches the system of claim 11 as described above. Martin further teaches a processor for encoding the stealth indicia by digitally signing a postage amount, an addressee information, a sender information, and a date (Martin: paragraph 0017, “The server then validates the payment information, and

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upon validation, generates an indicium based on the request, where the indicium includes a digital signature.” The Examiner interprets payment information to include a postage amount, an addressee information, a sender information, and a date.).

44. As per claim 15, Martin in view of Sansone teaches the system of claim 14 as described above. Martin further teaches the machine readable format is a bar code (Martin: paragraph 0006).

45. As per claim 16, Martin in view of Sansone teaches the system of claim 15 as described above. Martin further teaches the bar code is a 2-dimensional bar code (Martin: paragraph 0006).

46. As per claim 17, Martin in view of Sansone teaches the system of claim 11 as described above. Sansone further teaches means for verifying that the postage indicia has not previously been used on a second mailpiece (Sansone: column 6, lines 54-58, “Upon receipt of the postal imprint indicia, the CPU checks to confirm the correctness of the indicia as conforming to an authorized postal meter certification apparatus, previously established by the user”. The Examiner interprets confirming the correctness of the indicia as conforming to an authorized postal meter certification apparatus to include verifying that the postage indicia has not been previously used on a second mailpiece.).

47. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Martin to have included means for verifying that the postage indicia has not previously been used on a second mailpiece as taught by Sansone for the advantage of eliminating costly acceptance procedures set forth by the post office for reviewing bulk mail requirements (Sansone: column 6, lines 43-45).

48. Claims 7-8 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sansone et al., U.S. Patent No. 5,019,991 in view of Martin et al., U.S. Publication No. 2002/0046195.

49. As per claim 7, Sansone teaches a method of adjusting an amount of prepaid postage on a mailpiece, wherein the mailpiece comprises a postage indicia including an indication of an initial postage amount, comprising: receiving a payment for the initial postage amount (Sansone: column 5, lines 13-15, "postage has already been printed on the mailpiece"); receiving the mailpiece (Sansone: column 5, lines 13-15); verifying that the initial postage amount is the proper amount (Sansone: column 5, lines 15-18, "confirms whether the postage printed thereon is the correct postage"); billing a party for an adjusted postage amount, if the initial postage amount is not verified (Sansone: lines 19-21, "If the postage was not correct, then in block 1012 the descending registers are appropriately debited to reflect the correct postage"); and altering the postage indicia to reflect the adjusted postage amount, once the party has been billed for the adjusted amount (Sansone: column 5, lines 25-29, "an appropriate certification stamp is placed on the mail piece certifying that the mail has correctly been accounted for in the descending register of the user"). Sansone does not teach a postal indicia comprises the initial postage amount in only a machine readable format.

50. Martin teaches a postal indicia comprises the initial postage amount in only a machine readable format (Martin: paragraph 0006, lines 1-3).

51. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Sansone to have included a

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postal indicia comprising the initial postage amount in only a machine readable format as taught by Martin for the advantage of simplifying the use of postage meters while providing the required security (Martin: paragraph 0011, lines 1-3).

52. As per claim 8, Sansone in view of Martin teaches the method of claim 7 as described above. Martin further teaches the payment for initial postage amount is received via the Internet (Martin: paragraph 0037, "in one embodiment communications network 108 is the Internet").

53. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Sansone to have included paying for an initial postage amount via the Internet as taught by Martin for the advantage of allowing users to buy postage without suffering the inconvenience of using a postage meter (Martin: paragraph 0013, lines 1-3).

54. As per claim 18, Sansone teaches a system for adjusting an amount of prepaid postage on a mailpiece, comprising: means for receiving a payment for an initial postage amount (Sansone: column 5, lines 13-15, "postage has already been printed on the mailpiece"); means for receiving a mailpiece comprising a postage indicia (Sansone: column 5, lines 13-15); means for verifying that the initial postage amount is the proper amount (Sansone: column 5, lines 15-18, "confirms whether the postage printed thereon is the correct postage"); means for billing a party for an adjusted postage amount, if the initial postage amount is determined to be improper (Sansone: lines 19-21, "If the postage was not correct, then in block 1012 the descending registers are appropriately debited to reflect the correct postage"); and means for altering the postage indicia to reflect the adjusted postage amount, once the party has been billed for the adjusted amount

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(Sansone: column 5, lines 25-29, “an appropriate certification stamp is placed on the mail piece certifying that the mail has correctly been accounted for in the descending register of the user”). Sansone does not teach the postage indicia comprises the initial postage amount in only a machine readable format.

55. Martin teaches the postage indicia comprises the initial postage amount in only a machine readable format (Martin: paragraph 0006, lines 1-3).

56. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Sansone to have included the postage indicia comprises the initial postage amount in only a machine readable format as taught by Martin for the advantage of simplifying the use of postage meters while providing the required security (Martin: paragraph 0011, lines 1-3).

57. As per claim 19, Sansone in view of Martin teaches the system of claim 18 as described above. Martin further teaches the payment for initial postage amount is received via the Internet (Martin: paragraph 0037, “in one embodiment communications network 108 is the Internet”).

58. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Sansone to have included paying for an initial postage amount via the Internet as taught by Martin for the advantage of allowing users to buy postage without suffering the inconvenience of using a postage meter (Martin: paragraph 0013, lines 1-3).

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59. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manduley et al., U.S. Patent No. 5,324,893 in view of Sansone et al., U.S. Patent No. 5,019,991.

60. As per claim 9, Manduley teaches a system for coding a postage amount onto a mailing label, comprising means for receiving payment for a postage amount (Manduley: column 3, lines 23-26, "The term postage affixed to a mailpiece as used herein shall refer to both stamps and meter impressions signifying that value has been paid for the sending of the mailpiece") and a printer for producing a postage indicia (Manduley: Figure 1, "28", The Examiner notes, the printer taught by Manduley is capable of producing postage indicia that includes the postage amount in a format readable only by machine). Manduley does not teach accounting means for adjusting the postage amount at a time subsequent to receipt of payment.

61. Sansone teaches accounting means for adjusting the postage amount at a time subsequent to receipt of payment (Sansone: column 5, lines 19-21, "If the postage was not correct, then in block 1012 the descending registers are appropriately debited to reflect the correct postage.").

62. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Manduley to have included accounting means for adjusting the postage amount at a time subsequent to receipt of payment as taught by Sansone for the advantage of eliminating the need to return mail to a user in the event of a short payment (Sansone: column 2, lines 35-36).

63. As per claim 10, Manduley in view of Sansone teaches the system of claim 9 as described above. Manduley further teaches a printer for printing the adjusted postage

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amount on the postage indicia (Manduley: Figure 1, "28" and column 4, lines 27-30).

The Examiner notes, the printer taught by Manduley is readily capable of printing in a format readable only by machine.

64. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al., U.S. Publication No. 2003/0101143.

65. As per claim 35, Montgomery teaches the system of claim 29 as described above. Montgomery further teaches a scanner (Montgomery: Figure 8, "484"). Montgomery does not teach a portable scanner. The Examiner notes, the mere fact that a claimed device is portable or movable is not sufficient by itself to patentably distinguish over an otherwise old device unless there are new or unexpected results. See *In re Lindberg*, 194 F.2d 732, 93 USPQ 23 (CCPA 1952).

66. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Montgomery to have included a portable scanner for the advantage of detecting fraud on postal indicium (Montgomery: paragraph 0032).

67. Claims 36-41 and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al., U.S. Publication No. 2003/0101143 in view of Sansone et al., U.S. Patent No. 5,019,991.

68. As per claim 36, Montgomery teaches a system for verifying the proper postage on a mailpiece, comprising: a mailpiece including a stealth postage indicia comprising a postage amount represented in a format not readable by humans (Montgomery: Figure 2

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and paragraph 0088); a scanner for reading the postage amount (Montgomery: Figure 8, "484"); a scale for weighing the mailpiece and determining the proper postage for the mailpiece (Montgomery: Figure 4, "406"); and an interface in communication with the scanner and the scale (Montgomery: Figure 4, "402"). Montgomery does not teach verifying that the postage paid is the proper amount, and, if not, receiving payment for an adjusted amount.

69. Sansone teaches verifying that the postage paid is the proper amount, and, if not, receiving payment for an adjusted amount (Sansone: column 4, lines 8-15).

70. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Montgomery to have included verifying that the postage paid is the proper amount, and, if not, receiving payment for an adjusted amount as taught by Sansone for the advantage of eliminating the need to return mail to a user in the event of a short payment (Sansone: column 2, lines 35-36).

71. As per claim 37, Montgomery in view of Sansone teaches the system of claim 36 as described above. Montgomery further teaches an electronic interface for transmitting the stealth indicia to a user, and for receiving payment for the postage from the user (Montgomery: Figure 4, "308").

72. As per claim 38, Montgomery in view of Sansone teaches the system of claim 37 as described above. Montgomery further teaches the electronic interface is the Internet (Montgomery: paragraph 0091, communications links 314-322 may represent the Internet).

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73. As per claim 39, Montgomery teaches a method of coding an amount of postage onto a mailing label whereby the postage amount can be read only by machine (Montgomery: Figure 2 and paragraph 0088). Montgomery does not teach adjusting the postage amount after accepting the mailpiece from the sender.

74. Sansone teaches adjusting the postage amount after accepting the mailpiece from the sender (Sansone: column 4, lines 8-15).

75. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Montgomery to have included adjusting the postage amount after accepting the mailpiece from the sender as taught by Sansone for the advantage of eliminating the need to return mail to a user in the event of a short payment (Sansone: column 2, lines 35-36).

76. As per claim 40, Montgomery in view of Sansone teaches the method of claim 39 as described above. Montgomery further teaches the postage amount is represented in a bar code (Montgomery: Figure 2, "206").

77. As per claim 41, Montgomery in view of Sansone teaches the method of claim 39 as described above. Montgomery further teaches the mailing label further comprises at least two unique numbers for preventing the unauthorized use of the postage label (Montgomery: Figure 2, "204" and "218" and paragraph 0088).

78. As per claim 43, Montgomery teaches the method of claim 42 as described above. Montgomery does not teach verifying that the initial postage is the correct amount.

79. Sansone teaches verifying that the initial postage was the correct amount (Sansone: column 4, lines 8-12).

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80. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Montgomery to have included verifying that the initial postage is the correct amount as taught by Sansone for the advantage of eliminating the need to return mail to a user in the event of a short payment (Sansone: column 2, lines 35-36).

81. As per claim 44, Montgomery in view of Sansone teaches the method of claim 43 as described above. Sansone further teaches billing the sender for an adjusted amount if the initial postage amount was not correct (Sansone: column 4, lines 12-15).

82. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Montgomery to have included billing the sender for an adjusted amount if the initial postage amount was not correct as taught by Sansone for the advantage of eliminating the need to return mail to a user in the event of a short payment (Sansone: column 2, lines 35-36).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Liou whose telephone number is 571-270-1359. The examiner can normally be reached on Monday - Thursday, 7:30-5:00 and Friday 7:30-4:00 (first Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on 571-272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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